

Serial No. 10/670,427
Docket No. FJ-2003-014-US

5

REMARKS

Claims 1-16 are pending in the application. By this Amendment, Applicants have amended claims 1 and 7.

Applicants believe that entry of this Amendment is proper since the Amendment does not present new issues to the Examiner, which would require further consideration and/or search.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2, and 7 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 3-6, 8, 10, and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Oie (U.S. Patent No. 6,188,431 B1). Claims 9 and 12-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oie.

Applicants respectfully traverse these rejections in the following discussion.

I. THE CLAIMED INVENTION

The invention as recited in independent claim 1 for example, is directed to an image communication apparatus capable of communicating with a plurality of image communication apparatuses in a server-client system, including an image display device which displays a recorded image, a selection device which selects an image to be transmitted to another image communication apparatus from among images displayed on the image display device, and a transmission device capable of transmitting to one or more of the plurality of image communication apparatuses the image selected by the selection device when a request to send the image is received from a respective one of the one or more of the plurality of image communication apparatuses (Application at page 2, lines 7-14).

This structure is important because the image transmitting apparatus may transmit a selected image upon receipt of an image transmission request from another image communication apparatus so that the user of the other image communication apparatus can receive the image without requiring confirmation of the user's destination address

Serial No. 10/670,427
Docket No. FJ-2003-014-US

6

(Application at page 2, line 15-page 3, line 30).

In a conventional digital camera, as described in the Background of the present Application, a transmitter camera is required to determine if a receiver camera requested an image, set the destination address of the receiver camera and then perform a transmission operation (Application at page 1, lines 15-29).

In contrast, an exemplary aspect of the claimed invention may allow an image to be transmitted from a transmitting apparatus to a receiving apparatus without the transmitting apparatus determining if the receiving apparatus requested the image and setting the destination address (Application at page 11, lines 23-94).

None of the applied references discloses or suggests this invention.

II. THE WRITTEN DESCRIPTION REQUIREMENT REJECTION

The Examiner alleges that claims 1, 2, and 7 contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention. Specifically, the Examiner alleges that the originally filed specification does not provide support for “*a transmission device capable of transmitting to the plurality of image communication apparatuses the image selected by the selection device when a request to send the image is received from one or more of the plurality of image communication apparatuses*”.

While Applicants maintain that the original disclosure supports the above limitation is, merely in an effort to speed prosecution, Applicants have amended claim 1 to define the claimed invention more clearly.

Specifically, Applicants have amended claim 1 to recite, *inter alia*, “*a transmission device capable of transmitting to one or more of the plurality of image communication apparatuses the image selected by the selection device when a request to send the image is received from a respective one of said one or more of the plurality of image communication apparatuses”*. The originally filed disclosure supports this feature of the claimed invention, as indicated by the Examiner (e.g., see Office Action dated July 11, 2007 at page 2).

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Moreover, Applicants remind the Examiner that when determining whether the written description requirement of 35 U.S.C. § 112, first paragraph, is satisfied, “[r]egardless

Serial No. 10/670,427
Docket No. FJ-2003-014-US

7

of the outcome of the determination, Office personnel must complete the patentability requirement determination under all the relevant statutory provisions of title 35 of the U.S. Code.” (See M.P.E.P. § 2163 III; emphasis added by Applicants). All the relevant statutory provisions of title 35 of the U.S. Code include 35 U.S.C. §§ 101, 112, 102, and 103.

Since the Office Action does not include any further rejections (e.g., any prior art rejections under 35 U.S.C. §§ 102 and 103) of claims 1, 2, and 7, Applicants assume that the subject matter of claims 1, 2, and 7 is allowable if amended to overcome the rejection under 35 U.S.C. § 112, first paragraph.

If the Examiner wishes to reject claims 1, 2, and 7 under 35 U.S.C. §§ 102 and 103, Applicants respectfully request the Examiner to issue a new Office Action.

III. THE INDEFINITENESS REJECTION

The Examiner alleges that claim 7 is indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Specifically, the Examiner alleges that the phrase “the wireless image communication apparatus” does not have sufficient antecedent basis in the claims.

Applicants have amended claim 7 to provide proper antecedent basis for all of the claims terms. Specifically, Applicants have amended claim 7 to remove the term “wireless” from the preamble of the claim.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

IV. THE PRIOR ART REJECTIONS

The Examiner alleges that Oie teaches the claimed invention of claims 3-6, 8, 10, and 11. Furthermore, the Examiner alleges that the claimed invention of claims 9 and 12-16 would have been obvious in view of Oie. Applicants respectfully submit, however, that Oie does not teach or suggest (nor render obvious) each and every feature of the claimed invention.

For example, Oie fails to disclose or suggest, a transmission device capable of transmitting to one or more of the plurality of image communication apparatuses the image selected by the selection device when a request to send the image is received from a respective one of the one or more of the plurality of image communication apparatuses.

Serial No. 10/670,427
Docket No. FJ-2003-014-US

8

Oie discloses a master camera 1a and a slave camera 1b. Each of the cameras 1a and 1b have an LCD display 6 that displays selected images. When a user desires to transmit a selected image, the shutter key 9 is depressed and a negotiation process begins between the master camera (transmitting camera) and the slave camera (receiving camera) (col. 5, lines 50-62).

The negotiation process, as shown in Fig. 4 of Oie for example, includes a transmission code TC that sets the slave camera into a receive mode. The master camera then transmits the displayed image (col. 6, lines 7-16). Thus, the transmission of the image to the slave camera does not occur as a result of a request from the slave. Rather, the transmission is controlled by the master 1a.

Moreover, in Oie, the transmission and reception of an image only occurs between a master and slave camera. There is no disclosure or suggestion that the either the master camera 1a or the slave camera 1b is capable of transmitting to a plurality of image communication apparatuses the image selected by the selection device.

Applicants presented a similar argument to the Examiner in the Amendment filed on April 18, 2007. The Examiner has not rebutted this argument or responded to the substance of Applicants' argument. Accordingly, Applicants assume that the Examiner has conceded that Oie does not teach or suggest this feature of the claimed invention.

Regarding independent claim 3, Oie also fails to disclose or suggest, that either the master camera 1a or the slave camera 1b "searches for a server device when the mode selecting device is in the image reception mode."

In Oie, the master camera 1a is described as being able to either send or receive images from the slave camera (col. 5, line 49-col. 7, line 19). In other words in Oie, there are always only two known cameras involved in the process and no "search" takes place.

Regarding independent claim 6, Oie fails to disclose or suggest "selecting at a client side from a plurality of servers a server side to send a request for an image." As discussed above, in Oie there is always a one-to-one relationship between master and slave. As such, Oie does not disclose or suggest a plurality of possible sources from which to select an image.

Applicants respectfully submit that Applicants presented a similar argument, with respect to exemplary claims 3 and 6, to the Examiner in the Amendment filed on April 18, 2007. The Examiner has not responded to Applicants' traversal arguments.

Serial No. 10/670,427
Docket No. FJ-2003-014-US

9

The Examiner, however, alleges, “[i]t would have been inherent to search for a server device, i.e., a slave camera, when using wireless communication between more than one available slave cameras.” (See Office Action dated July 11, 2007 at page 4).

Applicants submit that the Examiner has clearly failed to meet his burden for establishing that the feature recited in exemplary claims 3 and 6 is inherent.

Applicants points out that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (See M.P.E.P. § 2112 IV; emphasis in M.P.E.P. itself). Indeed, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill’.” (See M.P.E.P. § 2112 IV; emphasis added by Applicant).

Furthermore, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (See M.P.E.P. § 2112 IV; emphasis added by Applicant).

Applicants point out that the Examiner has not provided any basis in fact and/or technical reasoning or extrinsic evidence to support his vague allegation of inherency. Indeed, the Examiner’s allegation appears to be nothing more than the Examiner’s personal opinion.

Since the Examiner has failed to meet his burden with respect to establishing inherency, the burden has not shifted to Applicants. Accordingly, Applicants are not required to provide any further rebuttal arguments until the Examiner has met his initial burden.

Furthermore, with respect to claim 3, the Examiner alleges that “Reception Code RC” in Figure 6 of Oie corresponds to the image transmitting request of the claimed invention. Since Oie discloses a push format, if there were multiple units of client, the images can only be sent after the server side designates and confirms the destination address for every case, which is troublesome.

The claimed invention, however, has resolved this inconvenience (e.g., see Application at page 3, lines 26-30). While the “Reception Code RC” of Oie is only applied in a case of 1-to-1 correspondence, the request transmitting device of the claimed invention can be applied even if there were multiple units of client.

Serial No. 10/670,427
Docket No. FJ-2003-014-US

10

Moreover, with respect to claims 9, 12, and 13, the Examiner indicates, "*Official Notice is taken that displaying a list of available servers with their respective broadcast domains detected during a search prior to establishing a connection is old and well known.*" (See Office Action dated July 11, 2007 at page 6).

Applicants respectfully submit, however, that the Examiner has failed to meet his burden regarding official notice.

According to M.P.E.P. §2144.03, official notice that is unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known are capable of instant and unquestionable demonstration as being well-known. Furthermore, general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support those findings will not support an obviousness rejection (See MPEP §2144.03). Finally, if official notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge (See MPEP §2144.03). In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Indeed, the Examiner has merely made a general conclusion that the features of claims 9, 12, and 13 are "well-known". Therefore, the Examiner has failed to meet his burden regarding official notice.

Since the Examiner has failed to meet his burden with respect to official notice, the burden has not shifted to Applicants. Accordingly, Applicants are not required to provide any further rebuttal arguments until the Examiner has met his initial burden.

V. NON-RESPONSIVENESS OF OFFICE ACTION

In the Office Action dated July 11, 2007, the Examiner stated, "Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection." (See Office Action dated July 11, 2007 at page 7). Applicants respectfully submit, however, that the above statement is not entirely correct.

That is, claims 1-6 were previously rejected under 35 U.S.C. § 102(b) as being anticipated by Oie (see Office Action dated December 28, 2006). Accordingly, Applicants

Serial No. 10/670,427
Docket No. FJ-2003-014-US

11

submitted traversal arguments rebutting the Examiner's rejection of claims 1-6 in the Amendment filed on April 18, 2007.

In the present Office Action, the Examiner has again rejected claims 3-6 under 35 U.S.C. § 102(b) as being anticipated by Oie (see Office Action dated July 11, 2007). Accordingly, Applicants traversal arguments with respect to claims 3-6 are not moot and the Examiner should have responded to the traversal arguments.

Accordingly, if the Examiner continued to maintain the current rejections based on Oie, Applicants respectfully request the Examiner to provide a complete response to each of Applicants' traversal arguments.

VI. CONCLUSION

Applicants concurrently file herewith a Petition for Extension of Time, and corresponding extension of time fee, for a two-month extension of time.

In view of the foregoing, Applicants submit that claims 1-16, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. Applicants respectfully request the Examiner to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, Applicants request the Examiner to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

RECEIVED
CENTRAL FAX CENTER

DEC 05 2007

Serial No. 10/670,427
Docket No. FJ-2003-014-US

12

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: December 5, 2007



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

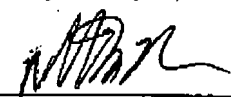
**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-3817(703) 761-4100
Customer No. 21254

FACSIMILE TRANSMISSION

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 2622, at (571) 273-8300, on December 5, 2007.

Respectfully Submitted,

Date: December 5, 2007



Scott M. Tulino, Esq.
Reg. No. 48,317

Sean M. McGinn, Esq.
Reg. No. 34,386